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APR 23 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application:

Clayman, et al.

Serial No.: 10/734,697

Filed: December 12, 2003

For: GUIDEWIRE

Docket No.: ADIV-1593-AU

Examiner: McCrosky, David J.

Group Art Unit: 3836

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being  
facsimile transmitted to the U.S. Patent and  
Trademark Office - Fax No. (703) 872-9306 on  
April 23, 2004

Barbara Johnson  
(Type or print name)

(Signature)

Dear Sir:

Attached please find the following documents submitted for filing in the above  
referenced application:

1. Amendment;
2. Amendment Transmittal; and
3. Copy of Notice Regarding Benefit/Priority Claim(s).

It is believed that all of the filing requirements have been met and this application  
should be in order for processing.

Respectfully submitted,



Kenneth K. Vu  
Registration No. 46,323

Applied Medical Resources Corporation  
22872 Avenida Empresa  
Rancho Santa Margarita, California 92688  
Telephone (949) 713-8000  
Facsimile (949) 713-8206

FORM PTO-1083 (fees 10/95)

AMENDMENT TRANSMITTAL LETTERRECEIVED  
CENTRAL FAX CENTER

APR 23 2004

In re application of: Clayman, et al.  
 Serial No.: 10/734,697  
 Filed: December 12, 2003  
 For: GUIDEWIRE

Attorney Docket No.: ADIV-1593-AU

Examiner: McCrosky, David J.

Group Art Unit: 3836

OFFICIAL

Mail Stop Fee Amendment  
 Commissioner for Patents  
 PO Box 1450  
 Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an amendment in the above-identified application.

- [X] Small entity status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a verified statement previously submitted.  
 [ ] A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

The filing fee has been calculated as shown below:

	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA
TOTAL	6	MINUS	20	0
INDEP.	1	MINUS	3	0
[ ] First Presentation of Multiple Dep. Claim				

SMALL ENTITY			OTHER THAN SMALL ENTITY	
RATE	ADDIT. FEE	or	RATE	ADDIT. FEE
x 9	0		x 18	-0-
x 43			x 84	-0-
+140	-	or	+280	-0-
Total Addit. Fee			Total Addit. Fee	
0			\$	

- ☐ Please charge my Deposit Account No. \_ the amount of \$ \_\_\_\_\_. A duplicate copy of this sheet is attached.
- ☐ Check No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_ is attached for payment of filing and extension fees for this amendment and Notice of Appeal filing fee.
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 01-2215.  
 A duplicate copy of this sheet is enclosed.  
☒ Any additional filing fees required under 37 C.F.R. 1.16.  
☒ Any patent application processing fees under 37 C.F.R. 1.17.

Respectfully submitted,



Kenneth K. Vu  
 Attorney for Applicant

Date April 23, 2004  
 22972 Avenida Empressa  
 Rancho Santa Margarita, California 92688  
 Telephone (949) 713-8000  
 Facsimile (949) 713-8206



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
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 P.O. Box 1452  
 Alexandria, Virginia 22113-1450  
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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/734,697	12/12/2003	Ralph V. Clayman	ADIV-1593

CONFIRMATION NO. 1218

21378

APPLIED MEDICAL RESOURCES CORPORATION  
 22872 Avenida Empresa  
 Rancho Santa Margarita, CA 92688



\*OC000000012158858\*

Date Mailed: 03/23/2004

## Notice Regarding Benefit/Priority Claim(s)

☐ Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)

The benefit claim(s) to prior-filed nonprovisional application(s) is improper because there is no specific reference for each prior-filed application that includes: (1) the identification of the prior-filed application by application number, or international application number and international filing date; and (2) a clear indication the relationship (i.e., continuation, divisional, or continuation-in-part) of the nonprovisional applications. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---," in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed application(s) as required by 37 CFR 1.78. A proper relationship includes an identification of each nonprovisional application as a continuation, divisional or continuation-in-part application of the immediate prior-filed nonprovisional application for which a benefit is claimed under 37 CFR 1.78 in order to establish copendency throughout the entire chain of prior-filed applications. The specific reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

**Timeliness:** The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed. See 37 CFR 1.78(a).

☐ Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)

The benefit claim(s) to prior-filed provisional application(s) is improper because the instant application was not filed within twelve (12) months from the filing date of the provisional application, and there is no indication of an intermediate nonprovisional application that is directly claiming the

benefit of the provisional application and filed within 12 months of the filing date of the provisional application. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---, which claims the benefit of U.S. Provisional Application No. 60/---,--- filed---." in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed applications (including an indication of any intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed with 12 months of the filing date of the provisional application) as required by 37 CFR 1.78. The required reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

**Timeliness:** The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed during the pendency of the instant application.

☐ **Improper Priority Claim(s) to Prior-Filed Foreign Application(s)**

The instant application was not filed within twelve (12) months from the filing date of the prior-filed foreign application, and there is no benefit claim to an intermediate nonprovisional application filed within 12 months of the filing date of the foreign application. Applicant should review each priority claim submitted and, if appropriate, provide the proper reference to any intermediate nonprovisional application filed within 12 months of the filing date of the foreign application in compliance with 37 CFR 1.78, or delete the priority claim. The required reference to an intermediate nonprovisional application must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

**Timeliness:** The required reference for the benefit claim to an intermediate nonprovisional application must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed.

☐ **Benefit Claims to More Than 400 Prior-Filed Applications**

The Office's automated system to record and capture benefit claims is only capable of recording benefit claims for 400 prior-filed applications. Therefore, the Office is unable to generate a filing receipt containing benefit claims for more than 400 prior-filed applications even though applicant is entitled to submit benefit claims for more than 400 prior-filed applications. Accordingly, applicant should not request a corrected filing receipt to include benefit claims for more than 400 prior-filed applications.



**Prior-Filed Nonprovisional Application has been Improperly Indicated as a National Stage (35 U.S.C. 371) Application**

Applicant submitted a benefit claim to a prior-filed nonprovisional application and improperly indicated that the prior-filed application is a national stage application under 35 U.S.C. 371. The Office's records show that the prior-filed application is an application filed under 35 U.S.C. 111(a). The Office has entered the benefit claim to the prior-filed application as a benefit claim to an application filed under 35 U.S.C. 111(a). Any request for a corrected filing receipt to include the indication that the prior-filed application is a national stage application will not be granted unless applicant supplies evidence that the prior application was in fact a national stage application. Accordingly, applicant should not submit such request without such evidence. Applicant should submit an amendment (or an application data sheet (ADS) if the benefit claim was submitted in an ADS) to delete the indication that the prior-filed application is a national stage application.

For more information and examples on benefit claims, please see Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. 119(e), 120, 121, and 365(c), 1268 Off. Gaz. Pat. Office 89 (March 18, 2003), which is available on the USPTO website at <http://www.uspto.gov/web/offices/com/sol/og/2003/week11/patbene.htm>, and the Manual of Patent Examining Procedure (MPEP) §§ 201.11 and 201.14.

PART 2 - COPY TO BE RETURNED WITH RESPONSE